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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,763	10/17/2001	William Sanford	11009-0021	8838

22865 7590 03/23/2004

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EXAMINER

AHMAD, NASSER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	09/981,763	SANFORD, WILLIAM	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Withdrawn

Claims 1-2, 6-9, 12 and 18-21 rejected under 35 U.S.C.102(b) as being anticipated by Burt for reasons of record in paper no..7, paragraph-3, mailed august 13, 2003.

Claims 8, 10 and 12 rejected under 35 U.S.C. 102(b) as being anticipated by Heimann for reasons of record in paper no. 7, paragraph-4.

Claims 1-10 and 12-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Burt in view of Heimann for reasons of record in paper no. 7, paragraph-6.

New Grounds of Rejection

The following are new grounds of rejection:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 4 and 24-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is found to be confusing in that it is unclear as to how are the label and the transparent laminate adhered to different sections of the backing, when each is straddling the split line as stated in claim 1.

As for claim 24, it is incomplete because in page 5 of the amendment, last line of claim 24 ends with the phrase "... second split-line; and". The following page 6 recites claim 25.

Hence, it is unclear as to what is being claimed in claim 24.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification teaches the sequential steps of removing and applying the label and the laminate to a substrate. However, it fails to provide support for the subject matter claimed in claims 22 and 23, in that the simultaneous removing of the two is not disclosed in the specification as originally filed.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-2, 4-9, 12 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Heuser (2,953,865).

Heuser relates to a label form (10) comprising a backing member (14) separated by split-line (16), a label (13) is removably attached to a first side of the backing member, and a transparent laminate (15) removably attached to the second side of the backing. The split-line separates the backing into a first and second section such that each of the label member and the transparent laminate straddle the split line (see figures 2-3 and 5). The label includes printable top surface (12). The label includes first and second shaped edges as shown in the drawings. The laminate includes a clear plastic. The backing includes release coating on both surfaces (col.2, lines 55-57). As shown in figures 2-3, the laminate does not cover the printable label member as the two are located on opposite side of the backing member. The laminate is wider than the label (col. 3, lines 38-43). The reference also discloses the method of applying the label of claim 18.

Regarding the intended use phrase "when the backing member is separated" (claims 4 and 14), and "adapted to" phrase have not been given any patentable weight because said phrases are not deemed to be of positive limitation in a product claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-10 and 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heuser.

Heuser, as discussed above, fails to teach that the label member and the transparent laminate are both located on the first side, that the laminate is approximately 0.25 inch wider than the label, and that the label and the laminate are simultaneously applied.

It would have been obvious to one having ordinary skill in the art to rearrange the parts by placing both the label and the laminate on the same side of the backing for reducing the thickness of the form to improve printer adaptability.

Regarding the width, it would have been obvious to optimize the width of the laminate for increasing the label surface protection.

As for the method of simultaneous applying the label and the laminate, it is found to of functional equivalence to the steps of sequential application because it provides for the same function of obtaining the labeled product, specially in the absence of any showing of criticality by the applicant.

8. Claims 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heuser.

Examiner has taken the position that the incomplete claim 24 relates to a label form comprising a backing member having two split-lines and the label member and the laminate are located on opposite side thereof.

Heuser, as discussed above, fails to teach the presence of a second split-line in the backing member. It would have been obvious to one having ordinary skill in the art at

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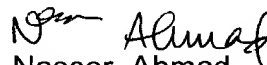
the time the invention was made to provide the backing of Heuser with a second split-line, based on duplication of parts, to provide for increased flexibility and ease of removal of the label and the laminate therefrom.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
March 16, 2004.